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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/533,482	12/20/90	TULLIS	101-8706
CAMPBELL AND FLORIES 4370 LAJOLLA VILLAGE DRIVE SUITE 700 LAJOLLA, CA 92122			EXAMINER
			MARTINELLI, J
			ART UNIT
			PAPER NUMBER
			16
			DATE MAILED: 12/18/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10/1/92 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 40-43, 45-47, 49, 51-61, and 63 are pending in the application.
Of the above, claims 40-43, 45-47, 49, 51, and 52 are withdrawn from consideration.
2. ☒ Claims 1-39, 44, 48, 50, and 62 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 53-61 and 63 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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EXAMINER'S ACTION

Serial No. 07/633,452
Art Unit 1805

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Claims 40-43, 45-47, 49, 51, and 52 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention. Election was made without traverse in Paper No. 9.

See MPEP 818.03(a).

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claims 53-61 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the preparation of stabilized forms of oligodeoxyribonucleotides that are phosphotriesters. See M.P.E.P. §§ 706.03(n) and 706.03(z). This is a new ground of rejection. The instant application does not give one of skill in the art guidance in connection with other forms of oligodeoxyribonucleotides that would be stable in vivo. In the absence of such a teaching, it would require undue experimentation for one of skill in the art to discover and synthesize such compounds.

Claims 53-60 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is repeated essentially for reasons already of record (e.g., Office action mailed August 6, 1991, page 3). The recitation of "stabilized form" is vague and indefinite. It is noted that the instant application mentions only one stabilized form (viz., phosphotriesters) and that those forms are claimed in the parent application (U.S. Patent No. 5,023,243).

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 53-61 are rejected under 35 U.S.C. § 103 as being unpatentable over Itakura et al in view of either one of Paterson et al or Hastie et al in further view of either one of Summerton or Miller et al. This rejection is repeated essentially for reasons already of record (e.g., Office action mailed August 1, 1991, pages 4-5). Applicant's arguments in paper no. 9 and in Exhibit A of paper no. 9 are not convincing because the instant claims are not limited in the same manner as were the claims in the parent application.

Claims 53-61 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Ts'o et al ('863). This rejection is repeated essentially for reasons already of record (e.g., Office action mailed August 1, 1991, page 5). Applicant's arguments (paper no. 9) and the copy of the Rule 131 declaration by Dr. Campbell are not convincing because a Rule 131 declaration can be filed only by the inventor.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1805.

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 308-4227.

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Any inquiry concerning this communication should be directed to J.
Martinell at telephone number (703) 308-0196.

Martinell

JAMES MARTINELL, Ph.
PRIMARY EXAMINER
ART UNIT 185/1805

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